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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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KAPLAN & GILMAN
COUNSELORS AT NORTH
900 ROUTE 9 NORTH
WOODBRIDGE, NJ 07095

EXAMINER	
PAULA, CESAR B	

ART UNIT	PAPER NUMBER
2178	

DATE MAILED: 08/12/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/197,844	JANAY, GAD	
	Examiner	Art Unit	
	CESAR B PAULA	2178	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *21 May 2004* .

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-18* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-18* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

1. This action is responsive to the RCE filed on 5/21/2004.

This action is made Non-Final.

2. In the response, claims 1-18 are pending in the case. Claims 5, 10-11, and 15 are independent claims.

Drawings

3. This application has been filed with informal drawings which are acceptable for examination purposes only. Formal drawings will be required when the application is allowed.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

5. Claims 1-3, 5-11, and 13-18 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Warmus et al, hereinafter Warmus (Pat.# 6,327,599, 12/4/01, filed 6/7/95), in view of Barnes, "10 Minute Guide To Windows 3.1", SAMS, 1992, p.119-123.

Regarding independent claim 1, Warmus discloses automatically intercepting a print job sent to a printer system 62 or 79 and adding additional variable information, which contain additional customized information while printing fixed information, after it leaves the user computer. New information is added onto the template to produce several documents containing different information in a format different from the format originally sent by the user—data and template (c.3, L.8-67, c.5, L.61-c.7, L.67, fig.3). Warmus fails to explicitly disclose *a print spool*. Barnes teaches a print manager spooler for feeding a print job to a designated printer (p.119-120). It would have been obvious to one of ordinary skill in the art at the time of the invention to have combined the teachings of Warmus, and Barnes, because Barnes teaches above a print manager for holding print jobs not printed by the printer. This would provide the benefit of keeping the print jobs in a queue, instead of losing the print jobs.

Furthermore, Warmus teaches the printing of additional information related to a print job. The additional information is retrieved from a database using the variable data in the templates for retrieving additional information from the database or as a key for the database (c.3, L.8-67, c.5, L.61-c.6, L.67).

Regarding claim 2, which depends on claims 1, Warmus teaches the printing of various books or book versions from the same single print job (col.7, lines 37-67).

Regarding claim 3, which depends on claims 1, Warmus teaches the printing of various books or book versions containing different or variable information which changes from book to book (col.7, lines 40-67).

Claims 5-6 are directed towards a tool for implementing the tool of claims 1-2, and therefore are similarly rejected.

Regarding claim 7, which depends on claim 5, Warmus discloses the intercepting of a document template—*original format*— to be printed and using this information for the retrieval of variable data from a database. New information is added onto the template to produce several documents containing different information in a double-side printing format (col.3, line 7-col.4, line 12, col.6, lines 1-67, and col.7, line1-col.8, lines 1-67).

Claims 8-10, and 13-14 are directed towards a formatting tool for implementing the tool of claims 3, 3, and (1 & 3), 1, and 3, and therefore are similarly rejected.

Regarding independent claim 11, Warmus discloses automatically intercepting a print job, with static, and variable information—*first, and second portion*-- sent to a printer and adding additional variable information from a database based upon the variable information or *keys,* which contain additional customized information. New information is added onto the template to produce several documents containing different information in a format different from the format originally sent by the user—data and template. One document having information not present in the other (c.3, L.8-67, c.5, L.61-c.7, L.67, fig. 6a-b).

Regarding independent claim 15, Warmus teaches the printing of various books or book

versions using template files, which have fixed data, and information for identifying locations for printing variable information (col.,6, lines 1-67, col.7, lines 37-67).

Moreover, Warmus teaches the formatting and interception of data before it reaches the printer, and inserting variable data located in a database (col.5, lines 60- col.6, line 67). Warmus fails to explicitly disclose *a print spool*. Barnes teaches a print manager spooler for feeding a print job to a designated printer (p.119-120). It would have been obvious to one of ordinary skill in the art at the time of the invention to have combined the teachings of Warmus, and Barnes, because Barnes teaches above a print manager for holding print jobs not printed by the printer. This would provide the benefit of keeping the print jobs in a queue, instead of losing the print jobs.

Furthermore, Warmus fails to explicitly disclose *parsing the identification segment*. It would have been obvious to one of ordinary skill in the art at the time of the invention to have parsed to identify the segment, because Warmus teaches the reading of variable template data to identify where to retrieve, and how to format the variable data (col. 6, lines 1-col.7, line 67).

Claims 16-18 are directed towards a method for implementing the tool of claims 2, 2, and 3, and therefore are similarly rejected.

6. Claims 4, and 12 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Warmus, in view of Barnes, and further in view of Ikenoue et al, hereinafter Ikenoue (Pat. # 5,987,127, 11/16/99, filed on 7/15/97).

Regarding claim 4, which depends on claim 3, Warmus discloses the intercepting of a document template—*original format*— to be printed and using this information for the retrieval of variable data from a database (col.3, line 7-col.4, line 12, col.6, lines 1-67, and col.7, line1-col.8, lines 1-67). Warmus fails to explicitly disclose *whether or not information is confidential.* Ikenoue teaches the embedding of additional data about a document, such as whether or not a document is secret, onto hard copies of a document for security and copyright purposes (col.2, lines 24-67, and col.5, lines 1-col.6, line 67). However, it would have been obvious to a person of ordinary skill in the art at the time of the invention to have combined the teachings of Warmus, Barnes, and Ikenoue, because Ikenoue teaches above an effective document copy management tool.

Regarding claim 12, which depends on claim 5, Warmus discloses the intercepting of a document template—*original format*— to be printed and using this information for the retrieval of variable data from a database (col.3, line 7-col.4, line 12, col.6, lines 1-67, and col.7, line1-col.8, lines 1-67). Warmus fails to explicitly disclose fails to explicitly disclose *second portion is a confidential portion.* Ikenoue teaches the embedding of additional data about a document, such as whether or not a document is secret, onto hard copies of a document for security and copyright purposes (col.2, lines 24-67, and col.5, lines 1-col.6, line 67). However, it would have been obvious to a person of ordinary skill in the art at the time of the invention to have combined the teachings of Corona, Barnes, and Warmus, and Ikenoue, because Ikenoue teaches above an effective document copy management tool.

Response to Arguments

7. Applicant's arguments filed 5/21/2004 have been fully considered but they are not persuasive. The applicant indicates that Warmus never teaches or implies the intercepting data after it arrives at the print spool (page 3, lines 9-19). The examiner disagrees, because Warmus teaches the sending of a template representing pages (from a book or such) to be printed, which has fixed and variable information, to demand printer(s) 62, or 79. The variable information is made up of data identifying entries stored in a database, which are to be retrieved and inserted into the template while printing the document, that is after leaving the sending computer. A user specifies or indicates the printing of the pages. As a result, these pages, which have the template with fixed and variable information, are sent to a printer system (fig. 3, 62), where the fixed pages are printed. In turn, while the fixed pages are being printed, the variable or customizable information is retrieved from a database using data in the template which refers to entries in the database. Once the database entries are retrieved, the printer proceeds to insert, and print such entries into the printed pages (col. 5, lines 61-67, col. 6, lines 1-9, 25-67, col. 8, lines 53-67, and fig.3). Warmus fails to explicitly disclose *a print spool*. Barnes teaches a print manager spooler for feeding a print job to a designated printer (p.119-120). It would have been obvious to one of ordinary skill in the art at the time of the invention to have combined the teachings of Warmus, and Barnes, and have included a print spool for managing the printing of the information, because Barnes teaches above a print manager for holding print jobs not printed by the printer. This would provide the benefit of freeing up memory resources, and keeping the print jobs in a queue, instead of losing the print jobs, such as the print job sent to the print system 62 taught by

Warmus. So that the pages sent to the printer are intercepted after leaving the print spool to the printer, and before it gets printed out at the printer.

After combining Warmus with the spooler from Barnes, the invention consists of receiving the document print job at the spooler, sending the job to the printer. While the system is printing the fixed information (after it has been sent to the printer from the print spool), retrieving the variable as intercepted from and described in the variable section of the document, information from the database, and then inserting it into the right location, and printing this additional variable information (col.8, lines 53-56).

Moreover, the applicant submits that the final variable page printed by system 62, or 79 have nothing to do with additional customized information, such as addressee information (page 4, lines 12-16). The examiner disagrees, because the variable information of the final variable page, is retrieved from database 108, which contains information such as addressee's names, addresses, etc., which corresponds to the information printed by the ink jet printers (col.9-10, lines 40-50).

Moreover, the applicant submits that both the fixed and variable information have already been printed by system 62, or 79 before forwarding the printed pages to the finishing apparatus 66 (page 4, lines 15-21). The examiner would like to clarify, that after combining Warmus with the spooler from Barnes, the invention consists of receiving the document print job at the spooler, sending the job to the printer. While the system is printing the fixed information (after it has left the spool, and arrived at the printer from the print spool), retrieving the variable

as intercepted from and described in the variable section of the document, information from the database, and then inserting it into the right location, and printing this additional variable information (col.8, lines 53-56).

Claims 2-4, 6-9, 12-14, and 16-18 are rejected at least based on the same reasons stated above.

Conclusion

1. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Configurable Document Composition Formatter, IBM TDB, November 1991, VOL.NO.34, ISS.NO. 6, PP.185-186.

I. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cesar B. Paula whose telephone number is **(703) 306-5543**. The examiner can normally be reached on Monday through Friday from 8:00 a.m. to 4:00 p.m. (EST).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen Hong, can be reached on (703) 308-5465. However, in such a case, please allow at least one business day.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-3900.

Any response to this Action should be mailed to:

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Or faxed to:

- **(703) 703-872-9306,** (for **all** Formal communications intended for entry)

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA, Sixth Floor (Receptionist).

CESAR B PAULA
Patent Examiner
Art Unit 2178

8/6/04